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**MAILED**

**AUG 27 2010**

**OFFICE OF PETITIONS**

In re Patent No. 7,186,800	:	DECISION ON REQUEST FOR
Issue Date: March 6, 2007	:	RECONSIDERATION OF
Gentz et al.	:	PATENT TERM ADJUSTMENT
Application No. 09/518,931	:	and
Filed: March 3, 2000	:	NOTICE OF INTENT TO ISSUE
Atty Docket No. PF454P1	:	CERTIFICATE OF CORRECTION
	:	

This is a decision on the "RESPONSE TO THE DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT" filed December 3, 2007. This paper was recently forwarded to the undersigned for consideration. Patentees request reconsideration of the Patent Term Adjustment indicated in the Decision on Application for Patent Term Adjustment mailed on January 9, 2007. Patentees continue to request that the determination of patent term adjustment of six hundred twenty-two (622) days be corrected to one thousand forty-three (1043) days.

The request for reconsideration of decision on application for patent term adjustment is GRANTED to the extent indicated.

For the reasons stated herein, the patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of one thousand three hundred thirty-eight (1338) days.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

### BACKGROUND

On July 12, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment<sup>1</sup> (PTA) to date is 1226 days.

On October 11, 2006, patentees timely submitted an application for patent term adjustment (with required fee). Therein, patentees indicated that both the period of adjustment of 1146 for Office delay in responding to patentees' reply and the period of adjustment of 206 days for Office delay due to an interference delay should not be entered. Patentees asserted that the period of adjustment of 206 days should be corrected to 0 days because the period of 206 days extending from July 17, 2003 until February 8, 2004, overlapped entirely with the period calculated for the 1146-day Office delay. Patentees did not otherwise dispute the period of suspension of 206 days.

By decision mailed January 9, 2007, the Office advised patentees that the entry of a period of delay of 1146 days pursuant to 37 CFR 1.702(a)(2) was incorrect. Specifically, there was no Office delay within the meaning of 37 CFR 1.702(a)(2). The decision concluded that on January 17, 2002, the Office mailed the Letter Regarding Suspension in response to, and within four months of, patentees filing of the amendment after final on November 20, 2001. Thus, there was no examination delay.

Moreover, the decision entered a total of 725 days (including the previously accorded 206 days) for examination delay pursuant to 1.702(c) for those periods during which issuance of the patent was delayed due to interference proceedings under 35 U.S.C. 135(a). With respect to the suspensions in this case, it was concluded that the periods of adjustment are properly 306 days for the period from January 16, 2002 to November 18, 2002,

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<sup>1</sup> This application became eligible for patent term adjustment for examination delay by virtue of the filing of a continuing prosecution application on October 25, 2000.

206 days for the period from July 17, 2003 to February 8, 2004, and 213 days for the period from June 9, 2004 to January 8, 2005 for a total of 725 days.

In view of the undisputed period of reduction of 126 days for applicant delay, the decision concluded that the patent term adjustment determination at the time of the mailing of the notice of allowance was 599 days (725 - 126).

After the mailing of the notice of allowance, an additional period of adjustment of 23 days was entered for the Office taking in excess of four months to issue the patent after the issue fee was paid and all outstanding requirements met. Accordingly, on March 6, 2007, the patent issued with a revised patent term adjustment of 622 days.

On March 7, 2007, patentees timely filed the first request for reconsideration of decision on application for patent term adjustment. By decision mailed October 1, 2007, the request for reconsideration was dismissed. The previous decision was affirmed. First, it was concluded that the Letter Regarding Suspension mailed January 17, 2002 was a notification under 132 and properly stopped the clock for determining examination delay pursuant to 37 CFR 1.702(a)(2). Thus, there was no Office delay within the meaning of 1.702(a)(2) for taking in excess of four months to respond to the "reply under 35 U.S.C. 132<sup>2</sup>" filed by applicants on November 20, 2001. Secondly, it was concluded that the period of adjustment for Office delay due to interference proceedings, pursuant to 37 CFR 1.703(c)(2), was correctly calculated as 725 days.

#### OPINION

On instant request for reconsideration, patentees contend (1) the Letter Regarding Suspension mailed by the Examiner on

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<sup>2</sup> As a preliminary matter, patentees dispute the characterization in the previous decision of the response filed November 20, 2001 as a "reply under 35 U.S.C. 132." Applicant states that an applicant cannot respond under 35 U.S.C. §132, but rather applicants respond as provided for in 37 C.F.R. §1.111 and §1.113. In response, patentees' attention is directed to the language of 35 U.S.C. §154(b)(1)(A)(ii) and 37 C.F.R. §1.702(a)(2) which both provide for an Office delay where the Office fails to respond to a "reply under 35 U.S.C. 132." The undersigned was guided by this language in her characterization of the response filed November 20, 2001. Within the language of the statute and the rule, the response filed November 20, 2001, is a "reply under 35 U.S.C. 132." More importantly, regardless of the characterization of the respond filed November 20, 2001, patentees surely do not dispute that as provided in the statute and the rule, the Office was required to take action within four months of the filing of the paper filed November 20, 2001 to avoid entry of a period of adjustment for Office delay. The issue is not the characterization of applicant's reply but what constituted an action under 35 U.S.C 132 by the Office in response.

January 17, 2002 did not comply with the requirements imposed by 35 U.S.C. §154(b)(1)(A)(ii), 35 U.S.C. §132, 37 C.F.R. §1.702(a)(2) and 37 C.F.R. §1.703(a)(3), and (2) the time period between January 8, 2005 when the suspension was arguably removed from the Application, and May 9, 2005, when the Examiner reopened prosecution should be included in the Patent Term Adjustment. Patentees' contentions have been considered, but their arguments in support thereof have not been found persuasive.

35 USC 154(b)(1)(A)(ii) provides:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to -

...

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

Accordingly, 37 CFR 1.702(a)(2) states, in pertinent part:

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

...

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

In this instance, there was no examination delay within the meaning of 35 USC 154(b)(1)(A)(ii) and 37 CFR 1.702(a)(2). The reply under 35 U.S.C. 132 was filed on November 20, 2001. The Letter Regarding Suspension mailed January 17, 2002, was mailed in response to and within four months of, the filing of the reply. Further, a review of the Letter Regarding Suspension makes clear that it is an Office action prepared by the examiner as a result of the examination conducted pursuant to 35 U.S.C. 131. For example, therein the amendment after final rejection was entered and patentees were advised as all claims were

allowable. The Letter Regarding Suspension is a notification under 132 and properly stops the clock for determining examination delay pursuant to 37 CFR 1.702(a)(2).

The delay in this instance is for interference proceedings not for Office delay in taking action in response to the amendment filed November 20, 2001. A review of the record confirms that the period of 725 days entered pursuant to 37 CFR 1.703(c)(2) is also correct. As previously stated, this period is limited to the number of days in the period beginning on the date prosecution in the application was suspended by the Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension. It was proper to use the dates of November 18, 2002, February 8, 2004 and January 8, 2005 for the dates of termination of suspensions. As stated in each letter, ex parte prosecution was

SUSPENDED FOR A PERIOD OF 6 MONTHS from the mail date of the letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

No inquiry having been made by patentees at the end of the 6 month period, nonetheless, the suspensions were terminated. The suspensions did not last until the mailing of the Office action on May 9, 2005.

The patent term adjustment was correctly calculated with respect to Office delay in responding to the reply filed November 20, 2001 and with respect to the periods of suspension.

However, a review of the record confirms that an entry of Office delay pursuant to 37 CFR 1.702(b) for the Office taking in excess of three years to issue the patent (not including any time consumed by interference proceedings) should have, but was not entered. 37 CFR 1.703(b) provides, in pertinent part, that:

The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a

patent was issued, but not including the sum of the following periods:

...

(2)(i) The number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

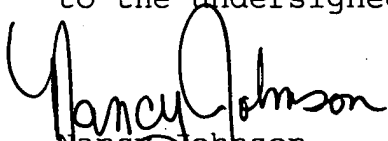
(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension;

In this instance, the patent issued three years and 1,464 days after the actual filing date. Not including the 725 days accorded for the suspension due to the interference and not including the 23 overlapping days of Office delay already accorded, a period of adjustment of 716 days should have been entered for Office delay.

In view thereof the patent should have issued with a revised patent term adjustment of one thousand three hundred thirty-eight (1338) days (622 + 716 days).

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one thousand three hundred thirty-eight (1338) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

  
Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE  
**CERTIFICATE OF CORRECTION**

PATENT : 7,186,800 B1

DATED : March 6, 2007

DRAFT

INVENTOR(S) : Gentz et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 622 days

Delete the phrase "by 622 days" and insert – by 1338 days--